Office-Supreme Court, U.S.
FILED
JAN 28 1985
ALEXANDER L. STEVAS,
CLERK

(2)

No. 84-664

In the Supreme Court of the United States

OCTOBER TERM, 1984

LESLIE N. WILDER, JAMES C. WHITNEY AND GARY G. MATISON, PETITIONERS

v.

GERALD J. MOSSINGHOFF, COMMISSIONER OF PATENTS AND TRADEMARKS, ET AL.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF FOR RESPONDENT MOSSINGHOFF IN OPPOSITION

REX E. LEE
Solicitor General
Department of Justice
Washington, D.C. 20530
(202) 633-2217

QUESTIONS PRESENTED

1. Whether due process requires at least one level of de novo judicial review of the factual findings of the Board of Appeals of the United States Patent and Trademark Office.

2. Whether the court of appeals' decision effectively abrogates the patent reissue laws.

TABLE OF CONTENTS

Page

Opinions below 1

Jurisdiction 1

Statutes involved 2

Statement 3

Argument 4

Conclusion 7

TABLE OF AUTHORITIES

Cases:

California Research Corp. v. *Ladd,* 356 F.2d 813 6

Camp v. *Pitts,* 411 U.S. 138 5

Citizens to Preserve Overton Park, Inc. v. *Volpe,* 401 U.S. 402 5

DeSeversky v. *Brenner,* 424 F.2d 857 6

FCC v. *National Citizens Comm. for Broadcasting,* 436 U.S. 775 5

Morgan v. *Daniels,* 153 U.S. 120 5-6

United States v. *United States Gypsum Co.,* 333 U.S. 364 5

Velsicol Chemical Corp. v. *Monsanto Co.,* 579 F.2d 1038 6

Watson v. *Bersworth,* 251 F.2d 898 6

Page

Statutes:

Administrative Procedure Act, 5 U.S.C. 551 *et seq.* 5

5 U.S.C. 706(2)(A) 5

5 U.S.C. 706(2)(E) 5

35 U.S.C. 112 ..... 2, 4

35 U.S.C. 141 5

35 U.S.C. 251 ..... 2, 3

Miscellaneous:

5 K. Davis, *Administrative Law Treatise* (2d 2d. 1984) 5

In the Supreme Court of the United States

OCTOBER TERM, 1984

No. 84-664

LESLIE N. WILDER, JAMES C. WHITNEY AND GARY G. MATISON, PETITIONERS

v.

GERALD J. MOSSINGHOFF, COMMISSIONER OF PATENTS AND TRADEMARKS, ET AL.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF FOR RESPONDENT MOSSINGHOFF IN OPPOSITION

OPINIONS BELOW

The opinion of the court of appeals (Pet. App. A1-A9) is reported at 736 F.2d 1516. The opinion of the Board of Appeals of the United States Patent and Trademark Office (Pet. App. A10-A26) is unreported.

JURISDICTION

The judgment of the court of appeals was entered on June 20, 1984. A petition for rehearing was denied on August 3, 1984 (Pet. App. A27). The petition for a writ of certiorari was filed on October 25, 1984. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

STATUTES INVOLVED

35 U.S.C. 251 provides:

> Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.
>
> The Commissioner may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.
>
> The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.
>
> No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

35 U.S.C. 112 provides in pertinent part:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and

> exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

STATEMENT

1. In September 1979, petitioners filed an application for reissue of a patent under 35 U.S.C. 251. The purpose of the application was to enlarge the scope of the claims of Patent No. 4,051,540, which had been issued to petitioners in 1977. Patent No. 4,051,540 concerns a mechanism for finding the location of information recorded on a dictation machine. A person speaking into the machine indicates the location of special instructions by the use of control tones. After rewinding the tape, a transcriptionist is able to locate these instructions by aligning an indicator with a light on a linear array. Pet. App. A2. Claim 1 of the patent stated that the apparatus "compris[ed]," among other things (*ibid.*):

> indexing means for scanning said array of light emitting sources in synchronism with the scanning of said record medium, said indexing means being in actuating relation sequentially with each of said light emitting sources * * *.

Petitioners included 16 claims in their reissue application (C.A. App. 15-18). Claims 1-13 were identical to claims 1-13 in the original patent and are not at issue here. Claims 14-16 are those that petitioners added to enlarge the scope of the original patent. In essence, claims 14-16 eliminated any limitation on the patent that would require that the visual display operate synchronously with the movement of the tape.

2. The primary examiner rejected claims 14-16 as not being drawn to the same invention disclosed in the original patent (C.A. App. 104). The Board of Appeals affirmed,

finding (Pet. App. A15) that the original patent did not contain an adequate description to support generic claims not requiring synchronous scanning. See 35 U.S.C. 112. The Board stated (Pet. App. A15):

> The original patent disclosure describes a species in which indexing means scans the array of lights emitting sources in synchronism with the scanning of the record medium and in which the indexing means is in actuating relation sequentially with each of the light emitting sources. There is not the slightest hint or allusion to any other means for assuring that the appropriate lights are energized to indicate the locations of the particular information signals on the record medium. The stated objects of the invention taken in conjunction with the detailed description of the apparatus do not constitute a disclosure of a broad invention not requiring the synchronous scanning and sequential actuating relationship.

The court of appeals affirmed the rejection of claims 14-16, holding that the Board's finding of inadequate description was not clearly erroneous (Pet. App. A7-A9).

ARGUMENT

The court of appeals' decision is correct, does not conflict with the ruling of any other court, and presents no significant question warranting further review by this Court.

1. Petitioners contend (Pet. 9) that "[i]t is a denial of due process for a court of appeals to apply the 'clearly erroneous' test to findings by a government agency without specific statutory authorization." Petitioners further argue (*ibid.*) that the Constitution requires at least one level of de novo judicial review of agency factfinding. Petitioners cite no authority for these far-reaching contentions, and they are devoid of merit.

As petitioners point out (Pet. 8), 35 U.S.C. 141, under which this appeal was taken to the Federal Circuit, provides no explicit standard of review for factual findings made by the Board of Appeals. As a result, it is necessary to look to the Administrative Procedure Act (APA), 5 U.S.C. 551 *et seq.* Since the finding in this case was not made after an adjudication "on the record," [1] the proper standard is set out in 5 U.S.C. 706(2)(A), which states that a

> reviewing court shall * * * hold unlawful and set aside agency * * * findings * * * found to be * * * arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law * * *.

This Court has held that under 5 U.S.C. 706(2)(A), agency findings may not be overturned unless "there has been a clear error of judgment." *Citizens to Preserve Overton Park, Inc.* v. *Volpe,* 401 U.S. 402, 416 (1971). See also, *e.g., FCC* v. *National Citizens Comm. for Broadcasting,* 436 U.S. 775, 802-803 (1978); *Camp* v. *Pitts,* 411 U.S. 138 (1973). This test is substantially equivalent to the "clearly erroneous" standard applied by the court of appeals in this case. See *United States* v. *United States Gypsum Co.,* 333 U.S. 364, 395 (1948) ("A finding is 'clearly erroneous' when, although there is evidence to support it, the reviewing court on the entire evidence is left with the definite and firm conviction that a mistake has been committed."); 5 K. Davis, *Administrative Law Treatise* § 29:5, at 354 (2d ed. 1984) (two standards "indistinguishable").

The court of appeals' holding is also consistent with the "thorough conviction" standard traditionally applied when district courts review findings made by Patent Office tribunals in patent and trademark cases. See *Morgan* v. *Daniels,*

---

[1] In such a case, the "substantial evidence" test of 5 U.S.C. 706(2)(E) would apply.

153 U.S. 120, 125 (1894); *Velsicol Chemical Corp.* v. *Monsanto Co.*, 579 F.2d 1038, 1042 (7th Cir. 1978); *DeSeversky* v. *Brenner*, 424 F.2d 857 (D.C. Cir. 1970); *California Research Corp.* v. *Ladd*, 356 F.2d 813 (D.C. Cir. 1966); *Watson* v. *Bersworth*, 251 F.2d 898 (D.C. Cir. 1958). That standard requires the court to give "controlling weight" to factual findings made by the Patent Office "unless the contrary is established by testimony which in character and amount carries thorough conviction." *Morgan* v. *Daniels*, 153 U.S. at 125. Petitioners have provided no grounds for concluding that either the APA or the "thorough conviction" standard violates due process.

In any event, the factual findings affirmed by the court of appeals are correct. Petitioners' disclosure at the time of their initial patent application set forth only one technique for actuating the dictating machine's indicating lights, a technique in synchronism with the tape scanning mechanism. If the light display lost its synchronous relationship with the tape cassette, the display would be totally useless because the indication lights would no longer correspond with the tape and provide a reliable indication of the location of special messages. Therefore, the Board of Appeals and the court of appeals were correct in determining that the original patent did not adequately describe the broader invention petitioners sought to claim in their reissue application (Pet. App. A8-A14).

2. Petitioners also argue (Pet. 13-19) that the court of appeals' decision abrogates the patent reissue laws by interpreting them "so narrowly that it now is practically impossible to obtain a reissue patent broadening the claims" (Pet. 13). Petitioners mischaracterize the court of appeals' holding. Petitioners assert (*ibid.*) that "the Court's ruling requires, in essence, that the applicant describe the invention in his original patent application as broadly as the broadened reissue claims he later seeks." However, the

court of appeals held (Pet. App. A8) that "[p]recisely how close the original description must come to comply with the description requirement of [35 U.S.C.] 112 must be determined on a case by case basis." The court then concluded (*ibid.*) that the Board's finding of inadequate description in this case was not clearly erroneous. Thus, contrary to petitioners' contention that the court of appeals gave the patent reissue laws a novel and far-reaching interpretation, the court merely rendered a fact-bound decision that does not warrant further review.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

REX E. LEE
Solicitor General

JANUARY 1985

DOJ-1985-01